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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/082,109	05/20/1998	JAMES HAWORTH	4532670/19300	2314

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DAVIS, BROWN, KOEHN, SHORS & ROBERTS, P.C.
THE FINANCIAL CENTER
666 WALNUT STREET
SUITE 2500
DES MOINES, IA 50309-3993

EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/15/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/082109

Applicant(s)

HAWORTH

Examiner

WEBMAN

Group Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/28/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12, 15, 20-22 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-12, 15, 20-22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 14
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Claim 21 in paper #12, filed 4/29/03, was renumbered to claim 22 per Rule 1.121. Claim 21, added in paper # 5, filed 10/29/99, remains under consideration.

Claims 1-12, 15, 18-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1(a) and 20 (a), the recitation of specific plants other than Rosemary is not disclosed in the specification. In claims 1(b), 20 (b), and 22 (b) "a boiling point above 22°C" is not disclosed in the specification.

In claim 22 (a) Rosmanol and Rosmarinic acid are not disclosed in the specification. Arnosol and Carnosic acid are only disclosed for Rosemary. Applicants argue that the new matter is well-known. However, the issue is what was contemplated at the time of filing.

Claims 1, 3-4, 6, 10-12, 15, 18-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for solvents recited on page 7 lines 3-7, does not reasonably provide enablement for any solvent with a boiling point above 22°C. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Nowhere in the specification do applicants disclose aromatics such as Benzene or Petroleum distillate fractions such as Ligroin.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9-12, 15, 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budavari et al in view of WO 95/26794 (WO '794).

Budavari et al teach that Rosemary is used in perfumery and contains oil of Rosemary.

WO '260 teaches extraction of flavored and aromatic oils from plants using C₁₋₄ (hydro) fluorocarbons and a co-solvent (abstract).

Tetrafluoroethane^o is disclosed (page 5, line 3), co-solvents include 2-6 Hydrocarbons including alkanes (page 5 second full paragraph). 50-99.5% fluorocarbon and 20-2% co solvent is specified (pages⁵ last paragraph bridging to page 6) recycling of extraction solvent is disclosed (page 7 full paragraph).

Elimination of high molecular weight wax impurities is disclosed (page 2 first full paragraph).

It would have been obvious to one of ordinary skill to use the WO '260 process to make the oil of Rosemary of Budavari et al to achieve the beneficial effect of eliminating wax impurities. As to the claimed extract in edible oil, such is well-known, even to the layman, in salad oils. For imparting^{im} flavor and aroma. As to the claimed antioxidants, they must be extracted as well, because the process of WO '260 is the same as that

claimed. Applicants argue that WO '260 teaches only co-solvents with a boiling point below 20°C. However, that range is merely preferred.

Applicants refer to GB 2234050 in paper #12, filed 4/29/03. However, the application is not of record. Further, the application number appears to be incorrect because it concerns an electrical device. The PCT search report and written opinion cited in paper # 12 ~~is~~ is also not of record.

Applicants' declaration, paper # 15, filed 4/29/03 was not considered because no evidence was provided in support thereof. See MPEP 715.07.

The examiner requests p. 450 of the Aruoma et al reference; it is not of record.


No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 308-4432. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1234.

Webman/tgd
August 27, 2003


EDWARD J. WEBMAN
Examiner
Art Unit 1617